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In re Patent Application of: KEVIN P. PARKER, *et al.*

Attorney's Docket No. PRKR-4600

Application No. 10/775,039

Group Art Unit: 3651

Filed: February 9, 2004

Examiner: Nicholson III, Leslie August

For: STACK CONDITIONING APPARATUS AND METHOD FOR USE IN BOOKBINDING

Mail Stop TECHNOLOGY CENTER 3600
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith are (1) *Petition to Director of Technology Center 3600 Under §1.181(a)(1)*; and (2) *Return Postcard* in the above-identified application

1. ☒ Please charge any fees associated with this filing, including any fees necessary for extensions of time, or credit overpayment to Deposit Account No. 50-1697. **A duplicate copy of this sheet is enclosed** for this purpose.
2. ☒ Petition for extension of time. The undersigned attorney of record hereby petitions for an extension of time pursuant to 37 C.F.R. § 1.136(a), as may be required, to file this response.

GIRARD & EQUITZ LLP

Oct. 9, 2007
Date

By: 

Philip A. Girard
Registration Number 28,848
Attorney(s) or Agent(s) of Record

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop TECHNOLOGY CENTER 3600, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 9, 2007.

Dated: 10/09/2007

By: 

Maria S. Cefalu



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

KEVIN P. PARKER, et al.

Application No. 10/775,039

Filed: February 9, 2004

For: STACK CONDITIONING APPARATUS
AND METHOD FOR USE IN
BOOKBINDING

Confirmation No. 6907

Group Art Unit: 3651

Examiner: Nicholson III, Leslie
August

**Petition to Director of
Technology Center 3600 Under
§1.181(a)(1)**

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GIRARD & EQUITZ LLP

Date: 10/09/2007

By: _____

Maria S. Cefalu

Applicants hereby petition the Director of Technology Center 3600 under §1.181(a)(1) to seek withdrawal of an Examiner's "final" objection to the form of certain claims under §1.113. As set forth in MPEP §1002.02(c), the Direction of Patents has delegated consideration of this type of petition under §1.113 to the relevant Technology Center Director, which in the present case is believed to be **Director John Love** of Technology Center 3600.

BACKGROUND

The objection at issue was made "final" by way of an Office Action mailed on July 16, 2006. Applicants requested reconsideration of this objection and

on July 30, 2007. Thus, Applicants have made a "proper request for reconsideration" under §1.181(c). The Examiner refused to withdraw the objection by way of an Office Action mailed on August 27, 2007 and failed to grant the requested interview. Thus, the subject petition is being made within the two month time period set forth in §1.181(f).

FEES

Applicants have been unable to ascertain whether or not a fee is required for the present petition. In the event a fee is required, the accompanying transmittal letter (submitted in duplicate) provides authorization to charge Deposit Account No. 501697 for the amount of the requisite fee. If a petition fee is required and the present petition is subsequently granted, Applicants hereby request a refund of such fee paid.

CLAIMS AT ISSUE

Product-by-process Claims 27, 29, 45 and 59 are at issue as set forth below:

Claim 27. A sheet conditioned in accordance with the method of Claim 26.

Claim 29. A sheet conditioned in accordance with the method of Claim 28.

Claim 45. A sheet conditioned in accordance with Claim 44.

Claim 59. A sheet conditioned in accordance with the method of Claim 58.

Claims 27, 29, 45 and 59 depend from respective method Claims 26, 28, 44 and 58 as follows:

Claim 26. A method of conditioning an edge of a stack of sheets to be bound, said method comprising:

- providing a piercing member;

- supporting the stack so that a compression force is applied to the stack in a region near the edge of the stack;

- periodically driving the piercing member into the edge of the stack in a first direction to engage the stack at a first location and withdrawing the piercing member from the first location at the edge of the stack in a second direction generally opposite the first direction; and

- moving the piercing member and the stack relative to one another at least once for each sheet of the stack so that each sheet of the stack is pierced by piercing member so that the edge of the stack is conditioned, with the conditioned edge being substantially linear before and after conditioning and with dimensions of the stack before and after conditioning being substantially constant.

Claim 28. The method of Claim 26 wherein the piercing member includes a plurality of individual spaced apart piercing elements aligned along a common axis and wherein the periodically driving includes driving the piercing elements into the edge of the stack with the common axis being substantially parallel with the edge of the stack.

Claim 44. The method of Claim 43 wherein the driving of the piercing members relative to the stack is such that the edge of the stack is linear subsequent to the conditioning and wherein stack dimensions prior and subsequent to the conditioning are substantially unchanged.

Claim 58. A method of conditioning an edge of a stack of sheets to be bound, said method comprising:

supporting the stack of sheets by applying a compression force to at least the edge of the stack, with the edge of the stack being disposed in an edge plane; and

repeatedly piercing the edge of the stack with a relatively rigid piercing member so that each sheet of the stack is contacted, with the piercing including contacting the edge of the stack substantially exclusively through the edge plane and including withdrawing from the edge of the stack substantially exclusively through the edge plane, with the edge of the stack being linear prior to and after the conditioning and with stack dimensions being substantially constant before and after the conditioning.

THE EXAMINER'S OBJECTION

Claims 27, 29, 45 and 46 are said to be improper dependent claims in that they do not comply with 37 CFR 1.75(c) in that such claims fail to limit the subject matter of the previous claim. (Note that these claims were also rejected under §112, §102 and §103, with these rejections not being relevant here.)

APPLICANT'S ARGUMENT IN RESPONSE

As explained in various responses to this objection (see June 12, 2007 Response to Office Action for example), this form of claim is specifically authorized in Ex parte Pattzer, 176 USPQ 141 (BD of App 1972) which is cited in the section of the MPEP dealing with product-by-process claims - MPEP at 2173.05(p). One set of claims at issue in that case included Claims 20, 23, 24 and 25 which are all product-by-process claims that depended from process claims. The rejection for being "improper" was reversed by the Board. As far as

being an improper dependent claim under 37 CFR 1.75, the MPEP states as follows at MPEP 608.01 (n) II (page 600-90 Rev 5, Aug 2006):

"Note that although 37 CFR 1.75(c) requires the dependent claims to further limit a preceding claim, this rule does not apply to product-by-process claims." [Emphasis added.]

CONCLUSION

In view of the foregoing, it is respectfully requested that the subject claim objections be withdrawn as being improper.

Respectfully submitted,

GIRARD & EQUITZ LLP

Dated: October 9, 2007

By: 

Philip A. Girard
Reg. No. 28,848

Attorneys for Applicant(s)

Attorney Docket No. PRKR-4600